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PATENT
CASE NO. PD0340K

Sprunell 4-12-96
DAC #9
Petition (Rule 181)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thomas J. Ambrosio et al.

Serial No. 08/446,804 — Art Unit: 3307

Filed: June 1, 1995 — Examiner: E. Raciti

For: INHALER FOR POWDERED MEDICATIONS

Box DAC
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. § 1.181

This is a petition to invoke the supervisory authority of the Commissioner of Patents and Trademarks in the matter of imposition of a requirement for an election of species in the above-identified application. If a fee of $130.00 is required in connection with this petition under 37 C.F.R. §1.17, or for a fee under any other rule, authorization to charge our Deposit Account No. 19-0365 for the appropriate amount is hereby given.

The petition is considered appropriate for filing at this time, since it has been asserted by the Office in two separate communications. It was first proposed in the Office Action (Paper No. 3) mailed December 20, 1995. After the applicants filed a traversal to obtain its withdrawal, the requirement was maintained in a communication (Paper No. 6) mailed on March 5, 1996. Thus, the requirement qualifies as being "final" for purposes of this petition.

Applicants hereby request withdrawal of the requirement for election of species, on the ground that no statutory basis exists for its imposition.

DISCUSSION

In the original Office Action, the requirement for election of species was said to be based upon provisions of 35 U.S.C. § 121. There were pointed out perceived "patentably distinct" species of dose plates, pawl drives, mouthpiece nozzles, bases and lower spring retainers, according to various features disclosed in the drawing figures of the application. Applicants were required to elect a single disclosed species of each, for prosecution, and the claims apparently will be restricted to such elected species if no generic claim is held to be allowable. Upon allowance of a generic claim, examination is to proceed under the provisions of 37 C.F.R. § 1.141.

The applicants responded to this requirement by pointing out that the provisions of 35 U.S.C. § 121 do not apply to applications (such as the above-identified application) which were filed in the U.S. through the Patent Cooperation Treaty ("PCT") under 35 U.S.C. § 371. Authority for this position is found in the Manual of Patent Examining Procedure ("M.P.E.P."), including its sections 801 and 1895.01(4). These sections, respectively, have pertinent parts which read as follows:

> This chapter is limited to a discussion of restriction ... as it relates to national applications filed under 35 U.S.C. 111. The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied ... in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the Patent and Trademark Office is covered in Chapter 1800.
>
> Restriction practice in both international and national stage applications is determined under unity of invention principles as set forth in 37 CFR 1.475 and 1.499. Restriction practice under 35 U.S.C. 121, as it applies to national applications submitted under 35 U.S.C. 111(a), is not applicable to either international or national stage applications.

Any perceived multiplicity of inventions must be dealt with in accordance with 37 C.F.R. § 1.475, which establishes a "single general inventive concept" standard for examination of the claims. As explained in the above-quoted M.P.E.P. sections, any requirement for election of species made in the subject application under 35 U.S.C. § 121 is erroneous and improper, and must not be maintained. Since this type of election appears to be authorized only by 35 U.S.C. § 121, imposition of the requirement in a PCT national phase application is wholly without statutory basis.

The reply to applicants' position reflects an erroneous interpretation of the applicable law. The reply purports to distinguish between requirements to elect between distinct or independent inventions and requirements for election of species, citing M.P.E.P. § 802.02. However, this section, by its own language, clearly states that the term "restriction" is generic to both.

Further instruction in this regard is found in the discussion which announces establishment of 37 C.F.R. § 1.129, found at 1174 O.G. 32 (May 2, 1995) in the second column:

> 104. Comment: One comment asked whether "restriction" under § 1.129(b) apply to election of species under § 1.146. Response: "Restriction" under § 1.129(b) applies to both requirements under § 1.142 and elections under § 1.146.
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> 110. Comment: One comment suggested that the standard for determining whether an application contains independent and distinct inventions should only be the "unity of invention" standard used for PCT applications. Response: The sugestion has not been adopted. The current restriction practice for 35 U.S.C. 111(a) applications is governed by 35 U.S.C. 121 and §§ 1.141, 1.142 and 1.146. The PCT "unity of invention" standard only applies to PCT applications and applications filed under 35 U.S.C. 371.

There can be no question that a requirement for election of species is generally regarded by the Office as being a "restriction" requirement. Since national phase applications are not to be subjected to restriction requirements, none of the restriction guidelines in Chapter 800 of the M.P.E.P. will be applicable. An attempt was made in Paper No. 6 to distinguish the practices by the citation of M.P.E.P. § 806.04(b), but this section clearly refers to election of species as merely being another type of restriction.

In order to preserve the application from abandonment, applicants have improperly been forced to provisionally elect from the various perceived species; this is being done in a concurrently filed paper. The requirement constitutes a violation of applicable treaty law, and must not be allowed to stand. Applicants are entitled to have the election requirement withdrawn, and to have the proper PCT unity of invention standard applied to their claimed invention. Prompt action on this petition will diminish the amount of time expended by the Office on searching only an inappropriate portion of the claimed invention.

The Commissioner is respectfully requested to grant relief by ordering the withdrawal of the impermissible requirement for election of species.

Respectfully submitted,

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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231, ON

March 19, 1996

Mar. 19, 1996 Robert A. Franks
(DATE SIGNED) ROBERT A. FRANKS
REG. NO. 28,605